

In the Office Action claims 12, 27-29 are rejected under 35 U.S.C. 102(e) over the U.S. patent to Kageler.

Also, claims 12-26 are rejected under 35 U.S.C. 102(b) over the patent Bhagwat.

The Examiner indicated that with respect to the anticipation rejection under 35 U.S.C. 102(e) based on the U.S. patent to Kageler, this rejection can be overcome by showing that any invention disclosed but not claimed in the reference was derived from the inventor of this application and thus is not the invention "by another", or by another appropriate showing.

With the present communication applicants have submitted a Declaration confirming that the inventors are applicants of the pending application serial no. 10/550,714 and they are the inventors of the subject matter and any invention disclosed but not claimed in the reference was derived from the inventors of this application and thus was not the invention "by another".

It is therefore respectfully requested to withdraw the Examiner's rejection of the claims based on the U.S. patent to Kageler, et al.

Turning now to the Examiner's rejection of the claims over the patent to Bhagwat, et al, and in particular the Examiner's rejection of claim 12, applicants have to respectfully disagree with the grounds for this rejection since in their opinion this rejection is not justified.

The patent to Bhagwat, et al does not show a cordless screwdriver with a charging cradle assembly. No charger at all is shown in the patent to Bhagwat, et al. The patent to Bhagwat, et al discloses a dual mode system for operating electrically powered devices, comprising a cordless battery pack and a cordless voltage converter.

Since no charger is disclosed in the patent to Bhagwat, et al, this reference also does not show the cordless screwdriver as a whole, placeable onto the charging cradle which automatically initiates a charging mode. Furthermore, the patent to Bhagwat, et al does not show that the cordless screwdriver is positioned on the charging cradle so that the housing of the cordless screwdriver is inclined relative to a horizontal plane and an end of the output spindle points downwards in the charging mode.

It is therefore believed to be clear that the new features of the present invention as defined in the amended claim 12 are not disclosed in the patent to Bhagwat, et al. In connection with this, it is believed to be advisable to cite the decision in re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Bhagwat does not disclose each and every element of the present invention which are now defined in claim 12, and therefore the anticipation rejection should be considered as not tenable with respect to this claim and should be withdrawn.

The present invention as defined in claim 12 can be considered as obvious from the patent to Bhagwat. The patent to Bhagwat does not provide any hint or suggestion for the above mentioned new features of the present invention. In order to arrive at the applicant's invention from the teaching of the patent to Bhagwat, the device disclosed in the reference has to be fundamentally modified by including into it the new features of the present invention which are now defined in claim 12 and were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented arguments, it is believed that claim 12 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 12, they share its presumably allowable features and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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